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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,902	11/02/1999	KAZUYUKI OHTSU	FUJY=16.705	9388
26304	7590	06/15/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			FERRIS, DERRICK W	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	

2663

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/431,902

Applicant(s)

OHTSU ET AL.

Examiner

Derrick W. Ferris

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-6 is/are allowed.
- 6) ☒ Claim(s) 1, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/19/2005 has been entered.

### *Response to Amendment*

1. **Claims 1-8** as amended are still in consideration for this application.
2. Examiner **withdraws** the obviousness rejection to *Vargo et al.* ("*Vargo*") in view of *Haeggstrom*. The rejection is withdrawn since based on the telephone interview with applicant on 6/6/2005, the examiner noted upon further review that the supporting reference *Haeggstrom* teaches tandem-free operation where TFO may not necessarily read on the claims with respect to a setting section (i.e., signalling may be used). As such, see the new rejection below which replaces the withdrawn rejection.
3. Examiner **withdraws** the anticipated rejection to *Shaffer*. The examiner agrees with applicant that it may not be clear that a judging section judges an input section compared to the set compression. In particular, the gateway must query the downstream path before a decision is made such that no compression is previously set. The new rejection below may clarify the above feature.

### *Claim Rejections - 35 USC § 103*

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 7, and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,577,637 B1 to *Sieppi et al.* ("*Sieppi*") in view of U.S. Patent No. 6,356,545 B1 to *Vargo et al.* ("*Vargo*").

As such to **claim 1**, *Sieppi* discloses e.g., in figure 1 a circuit switched network as part of the wireless network and an Internet protocol network as the Internet. As such, the gateway as taught as the combination of the BSC and the MSC/VLR in figure 1 or equivalent where the SSTDM performs the judging section and the setting section is performed based on the two states of the CODEC, see e.g., column 7, lines 13-40 and column 12, lines 26-50. In particular, the subscriber station type determining means (SSTDM) determines the type of connection for the IP terminal since it is assumed that the first station in the wireless network always uses a CODEC, see e.g., column 9, lines 43-54. Thus the subscriber station type determining means determines if the second station uses a CODEC. If the second station uses a CODEC (i.e., the compression forms coincide) then no compression is performed at the "gateway" (i.e., a pass through state is performed at the controller) and if the second station does not use a CODEC (i.e., the compression forms do not coincide) then compression is performed at the "gateway" (i.e., the compressed data received from the circuit switched network is expanded by the expansion section and then compressed by the compression section). In other words, a

judgment is made by the SSTDM based on whether compression is set or not at the IP network. When compression is set for the IP side of the link then a pass-through is performed (i.e., no processing of the CODEC or expansion/compression) in order to avoid double compression, otherwise compression is performed.

*Sieppi* may silent or deficient to the further limitation of the expanded data expanded by the expansion section is compressed by said compression section *at the compression for set by said setting section*. In particular, it may not be clear from *Sieppi* what CODEC is selected if a pass-thought is not performed.

*Vargo* teaches the further recited limitation above at e.g., the background at column 2, line 7-26. In particular, *Vargo* teaches that one skilled in the art would know to match the CODECs at either end of a communications link.

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Sieppi* by clarifying that the CODEC selected compresses the data that matches the other side of the link.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference or to combine the reference teachings would be to match the compression used at either end of the link. In particular, *Vargo* cures the above-cited deficiency by providing a motivation found at e.g., the background at column 2, line 7-26. Second, there would be a reasonable expectation of success since both references teach using CODECs. Thus the references either in singular or in combination teach the above claim limitation(s).

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As to **claim 7**, see similar rejection to claim 1 where a lower-order network is the wireless network and a high-order network is the Internet.

As to **claim 8**, see similar rejection to claim 1 where a high-order network is the wireless network and a low-order network is the Internet.

***Allowable Subject Matter***

3. **Claims 2-5** are allowed.

***Conclusion***

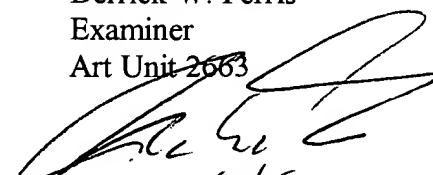
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (571) 272-3123. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571)272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
DWF

Derrick W. Ferris  
Examiner  
Art Unit 2663

  
9/10/05